

REMARKS

With this amendment, Applicants cancel claim 15. Claims 2-6, 12 and 14 are all the claims pending in the application.

I. Claim Rejections Under 35 U.S.C. § 103

The Examiner has rejected claims 2-5, 12 and 15 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,056,451 to Seki et al. (“Seki”) in view of U.S. Patent No. 5,212,512 to Shiota (“Shiota”). For at least the following reasons, Applicants traverse the rejection.

Claim 5 recites an image reading apparatus that comprises “a transport merging portion [that] is provided in an intersecting portion of a film transporting path of the film transporting portion, the reading transport path and the film output path ... [and] a transport switching section, which is provided in the transport merging portion, for switching between a state in which the photographic film transported by the film transporting portion is guided to the reading transport path, and a state in which the photographic film transported from the reading transport path to the transport merging portion by the reading transporting portion is guided to the film output path.” The Examiner concedes that the claimed transport merging portion with the claimed transport switching section is not disclosed by Seki but applies Shiota to allegedly cure the deficiency. The Examiner contends that film feed rollers 86 correspond to the claimed transporting merging portion. The Examiner also contends that one skilled in the art would have combined the teachings of Seki and Shiota since it would be an efficient way to utilize the film loader and save costs associated with separate hardware. Office Action at pages 6 and 7.

Shiota discloses that film feed rollers 86 are used in the unwinding and rewinding of the film from/to the cartridge 30 as it is transported to/from the exposure unit (see Fig. 4, col. 6, lines 44-49). There is no disclosure or suggestion in Shiota that film feed rollers 86 transport to any locations other than film cartridge 30 and the exposure unit. Therefore, even if, for the sake of argument alone, rollers 86 correspond to a transport merging portion, rollers 86 only represent the intersecting portion of two paths, i.e., the path into the rollers 86 and the path out of rollers 86.

As set forth in claim 5, the claimed transporting switching section, which is provided in the transport merging portion, is in the intersection portion of three paths, i.e., the film transport path, the reading transport path and the film output path. The transportation of the photographic film is switched among the paths, e.g., “a state in which the photographic film transported from the film transporting path is guided to the reading transport path, and a state in which the photographic film transported from the reading transport path is guided to the film output path,” by the claimed transport switching section.

Therefore, Applicants submit that the combination of Seki and Shiota still would not disclose at least the claimed transport switching section, which is provided in the transport merging portion as set forth in claim 5.

In addition, because film feed rollers 86 (the alleged transport merging portion) only transport the film between cartridge 30 and the exposure unit, the film transportation disclosed by Shiota correspond to the unwinding of the film from cartridge 30 and the rewinding of the film back into cartridge 30. Applicants submit that incorporating the teachings related to the film

feeding section 40 and the film feed rollers 86 of Shiota into the system of Seki, as suggested by the Examiner, would require that the film be rewound back to reel 1 of Seki since there is no other film transport path disclosed by Shiota.

Seki clearly discloses that its system is designed to take a film roll that comprises a plurality of individual films that are spliced together. Seki also discloses that the films are separated into individual films, which correspond to the respective client's orders, before exposure. See at least col. 2, lines 17-26, Figs. 2 and 3. Therefore, the system in Seki is not designed to rewind the film back to reel 1 since the plurality of films on reel 1 must be cut to the individual orders. Accordingly, modifying the system as suggested by the Examiner would change the principle of operation of Seki.

The MPEP is clear in that “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” MPEP at 2100-138. Here, the Examiner not only does not rebut that the principle of operation of Seki would change but concedes that “[i]t is very possible that modifying the invention of Seki [as suggested] would change its principle of operation.¹” Office Action at page 3 (underline in original). Accordingly, Applicants submit that the Examiner's admissions along with the

¹ Applicants submit that the Examiner's comments with respect to the operability of the modification (Office Action at page 3) are not relevant with respect to the issue of change in principle of operation, i.e., even if the invention is operable after being modified, the modification still would not be obvious to one skilled in the art if it changes the principle of operation.

guidelines set forth in the MPEP require that the Examiner withdraw the rejection based on Seki in view of Shiota.

In addition, Applicants submit that the Examiner's proffered reason for combining the references, which implies that there would be cost savings because separate hardware would not be needed, is not supported by any citation in the prior art. The Examiner also does not provide any substantive details as to how the alleged cost savings and/or separate hardware reduction would take place. Without such details or support in the prior art, Applicants submit that the Examiner's proffered reason for combining the references is mere speculation and such speculation does not fulfill the Agency's obligation to provide evidence in the record. See MPEP at 2100-143.

Applicants submit that claims 2-4 and 12 are patentable at least by virtue of their dependency on claim 5. Claim 15 has been canceled.

The Examiner has rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over Seki in view of U.S. Patent No. 6,470,101 to Nakamura ("Nakamura"). For at least the following reasons, Applicants traverse the rejection.

Because Nakamura does not cure the deficient teachings of Seki and Shiota given above with respect to claim 5, Applicants submit that claim 14 is patentable at least by virtue of its dependency on claim 5.

In addition, claim 14 recites an image reading apparatus "wherein the image reading section has a film take-up section which takes up the photographic film such that the photographic film which has been subject to the pre-scanning is accommodated to the film take-

up section, thereafter, the photographic film which has been subject to the pre-scanning is conveyed from the film take-up section in order to be subject to the fine scanning.” The Examiner takes official notice that pre-scanning and fine-scanning are known in the art.

In response to Applicant’s arguments in the Amendment filed on August 15, 2005, that the claimed directions are not rendered obvious by Seki in view of Nakamura since pre-scanning and fine-scanning may be done in the same direction, the Examiner contends that the claimed feature is an obvious variation “since performing pre scan and fine scan as a parallel processing are taught by Nakamura.” Office Action at pages 9 and 10.

Applicants submit that Nakamura does not disclose or suggest that pre-scanning and fine-scanning are done in parallel. However, if Nakamura did disclose pre-scanning and fine-scanning in parallel as suggested by the Examiner, the “parallel” scanning would have to be done at the same time and, therefore, with the film traveling in one direction.

Accordingly, the Examiner’s proffered reason for contending that the claimed directions for pre-scanning and fine-scanning would have been implicitly obvious to one skilled in the art is not supported by the prior art. Because the Examiner has failed to provide evidence in the record to support his contentions, Applicants submit that the Examiner has failed to make a *prima facie* case of obviousness with respect to the claimed pre-scanning and fine-scanning directions as set forth in claim 14.

The Examiner has rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Seki in view of Shiota and Nakamura. For at least the following reasons, Applicants traverse the rejection.

Because claim 6 recites features similar to those given above with respect to claim 14, Applicants submit that claim 6 is patentable for at least reasons similar to those given above with respect to claim 14.

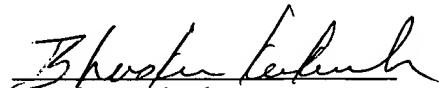
In addition, because Nakamura does not cure the deficient teachings of Seki and Shiota given above with respect to claim 5, Applicants submit that claim 6 is patentable at least by virtue of its dependency on claim 5.

II. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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